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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,694	02/01/2001	Yuichi Higuchi	03500.015094.	3090
5514	7590	04/16/2008	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			JACOBS, LASHONDA T	
ART UNIT		PAPER NUMBER		
2157				
MAIL DATE		DELIVERY MODE		
04/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/774,694	HIGUCHI, YUICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	LASHONDA T. JACOBS	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 January 2008.

2a) This action is **FINAL**.                                   2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8,21-28,41-48 and 80-82 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8,21-28,41-48 and 80-82 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This is a Final Office Action response to Applicant's Amendment filed on January 3, 2008.

Claims 1, 6, 21, 26, 41-48 have been amended. Claims 74 and 76-79 have been cancelled.

Applicant's newly adds claims 80-82. Claims 1-8, 21-28 and 41-48 are presented for further examination. Claims 80-82 are also presented for examination.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "the search condition" in line 16. There is insufficient antecedent basis for this limitation in the claim.

3. Claim 21 recites the limitation "the search condition" in line 14. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 41 recites the limitation "the search condition" in line 17. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **1-8, 21-28, 41-48** and **80-82** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiohara (U.S. Pat. No. 6,804,019) in view of Moro et al (hereinafter, "Moro", U.S. Pat. No. 6,327,051) and in further view of Osada et al (hereinafter, "Osada", U.S. Pat. No. 6,211,966).

As per claims **1, 21** and **41**, Shiohara discloses a server, an information processing method, and a computer readable medium which can communicate with a device, comprising:

- first storage unit adapted to store information representing an ability of the device (col. 4, lines 9-18);
- second storage unit adapted to store information representing an ability of a device driver for the device (col. 4, lines 42-49); and
- a retrieval condition reception unit adapted to receive a retrieval condition including at least one item for selecting the device (col. 5, lines 66-67 and col. 6, lines 1-6).

However, Shiohara does not explicitly disclose:

- a comparing unit adapted to compare the retrieval condition received by said retrieval condition unit with combined information, the combined information being a combination of the information stored by said first storage unit and the information stored by said second storage unit; and
- an output unit adapted to output a result of comparing by said comparing unit.

Moro discloses a printing control apparatus and method including:

- a comparing unit adapted to compare the retrieval condition received by said retrieval condition unit with combined information, the combined information being a

combination of the information stored by said first storage unit and the information stored by said second storage unit (col. 6, lines 52-67, col. 7, lines 1-33 and col. 32, lines 29-63); and

- an output unit adapted to output a comparing result obtained by said comparing unit (col. 6, lines 52-67, col. 7, lines 1-33 and col. 32, lines 29-63) .

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Moro's teaching of combining information to conform to results of printing desired by the user in a timely and efficient manner.

While the combined system of Shiohara and Moro, substantially discloses the invention as claimed discussed above, it does not explicitly disclose

- wherein the output unit outputs information for identifying, among the at least one item in the search condition, an item which does not conform to the ability of the device but conforms to the ability of the device driver.

Osada discloses a peripheral device control system comprising:

- wherein the output unit outputs information for identifying, among the at least one item in the search condition, an item which does not conform to the ability of the device but conforms to the ability of the device driver (col. 5, lines 6-13, col. 7, lines 56-67, col. 8, lines 1-8, col. 9, lines 42-67 and col. 10, lines 1-5).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the system of Shiohara and Moro by storing ability or service information in a storage device to allow a client to inquire about the ability of a device for the purpose of

providing a peripheral device and storing medium to enable a function to be sufficiently utilized can be performed from the client side.

As per claims **2, 22 and 42**, Shiohara further discloses:

- first reception unit adapted to receive the information representing the ability of the device (col. 4, lines 9-18); and
- second reception unit adapted to receive the information representing the ability of the device driver for the device (col. 4, lines 42-49).

As per claims **3, 23 and 43**, Shiohara discloses the invention substantially as claims discussed above:

However, Shiohara does not explicitly disclose:

- a generation unit adapted to generate the combined information by combining the information stored by first storage unit and the information stored by said second storage unit together.

Moro discloses a printing control apparatus and method including:

- a generation unit adapted to generate the combined information by combining the information stored by first storage unit and the information stored by said second storage unit together (col. 6, lines 52-67, col. 7, lines 1-33 and col. 32, lines 29-63) .

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Moro's teaching of combining information to conform to results of printing desired by the user in a timely and efficient manner.

As per claims **4, 24 and 44**, Shiohara further discloses:

- a third storage unit adapted to store the information generated by said generation means to a storage unit (col. 4, lines 19-29).

As per claims **5, 25 and 45**, Shiohara discloses the invention substantially as claims discussed above.

However, Shiohara does not explicitly disclose:

- wherein said comparing unit compares the combined information stored by said third storage unit with the retrieval condition.

Moro discloses a printing control apparatus and method including:

- wherein said comparing unit compares the combined information stored by said third storage unit with the retrieval condition (col. 6, lines 52-67, col. 7, lines 1-33 and col. 32, lines 29-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Moro's teaching of combining information to conform to results of printing desired by the user in a timely and efficient manner.

As per claims **6, 26 and 46**, Shiohara discloses:

- said output unit outputs an adaptivity based on the number of adapted item(s) among the at least one item included in the retrieval condition (col. 5, lines 66-67 and col. 6, lines 1-6).

However, Shiohara does not explicitly disclose:

- wherein said comparing unit compares the information stored by said first storage unit and, the information stored by said second storage unit with each condition included in the retrieval condition.

Moro discloses a printing control apparatus and method including:

- wherein said comparing unit compares the information stored by said first storage unit and, the information stored by said second storage unit with each condition included in the retrieval condition (col. 6, lines 52-67, col. 7, lines 1-33 and col. 32, lines 29-63) .

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Moro's teaching of combining information to conform to results of printing desired by the user in a timely and efficient manner.

As per claims **7, 27, and 47**, Shiohara discloses:

- wherein the first information representing the ability of the device is information concerning any one of a duplex print, an N-up print, a job copy, a page copy, an OHP insertion print, a resolution, the number of print pages, a paper size, and a status of said device (col. 3, lines 1-3 and col. 5, lines 1-19).

As per claims **8, 28 and 48**, Shiohara discloses:

- wherein the comparing by said comparing unit is performed with respect to plural devices (col. 6, lines 15-24).

As per claims **74 and 75**, Shiohara discloses the invention substantially as claims discussed above.

However, Shiohara does not explicitly disclose:

- wherein said output unit outputs the comparing result in a form for discriminating the function executable by the device driver, as the result of the comparing by said comparing unit.

Moro discloses a printing control apparatus and method including:

- wherein said output unit outputs the comparing result in a form for discriminating the function executable by the device driver, as the result of the comparing by said comparing unit (col. 6, lines 52-67, col. 7, lines 1-33 and col. 32, lines 29-63) .

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Moro's teaching of combining information to conform to results of printing desired by the user in a timely and efficient manner.

As per claims **80, 81, and 82**, Shiohara discloses:

- wherein the at least one item included in the search condition is information concerning any one of a duplex print, an N-up print, a job copy, a page copy, an OHP insertion print, a resolution, the number of print pages, a paper size, and a status of said device (col. 3, lines 1-3 and col. 5, lines 1-19).

#### *Response to Arguments*

7. Applicant's arguments with respect to claims **1-8, 21-28, 41-48** and **80-82** have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LASHONDA T. JACOBS whose telephone number is (571)272-4004. The examiner can normally be reached on 8:30 A.M.-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/LaShonda T Jacobs/  
Primary Examiner, Art Unit 2157

ltj  
April 12, 2008